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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|------------------------|---------------------|------------------|
| 09/944,995 | 08/31/2001 | Arthur Charles Lindahl | LINDAHL-CIP1 | 2432 |
| 7590 | 09/08/2004 | | EXAMINER | |
| Curt Harrington Suite 250 6300 State University Drive Long Beach, CA 90815 | | | NERBUN, PETER P | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3765 | |
| DATE MAILED: 09/08/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------|-------------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/944,995 | LINDAHL, ARTHUR CHARLES |
| | Examiner | Art Unit |
| | Peter P. Nerbun | 3765 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 17 May 2004.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-48 is/are pending in the application.

4a) Of the above claim(s) 5,6,9,10,12,18,19,22-29,33-44 and 46-48 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-4,7,8,11,13,20,21,30-32 and 45 is/are rejected.

7) Claim(s) 14-17 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4,7,8,11,13,20,21,30,31, and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Vinas, taken as applied in the previous Office action. The patent to Vinas discloses a removable eyewear member 2d, Fig. 4 for user selectable employment by a person wearing conventional eyewear 1d, Fig. 4, said eyewear member comprising a substantially planar, thin walled body 102d utilizable with conventional eyewear, said body having an enclosure with at least one enlarged opening 75d, said enlarged opening to align with a lens of said eyewear, said body to provide a close fit with a face of the person using said eyewear member to diminish the entry of foreign material and light between the eyewear and the person's face, said eyewear member having at least one projection 140 for extending around conventional eyewear and attached to said eyewear member for mounting said eyewear member in juxtaposition to the conventional eyewear. Note that the projection 140, Fig. 4 projects from the eyewear member since it extends outward therefrom. With regard to claim 11 note that element 42d is a strip since a strip is a long narrow piece of material. With regard to claim 21, note the Fig. 1 embodiment in Vinas.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vinas, taken as applied in the previous Office action. Col. 5, lines 8-10 of Vinas states that shielding element 42 is constructed of open-cell foam that allows passage of air, but resists the passage of solid or liquid matter. It would have been obvious to form the entire foam layer such that it is impermeable to liquid since Vinas intends to make foam element resistant to permeability by a liquid. If the entire foam layer is constructed so as to be impermeable to liquid then the surfaces thereof would also be impermeable to liquid since the surfaces of the layer are a part of the layer itself.

Claim 14 and its dependent claims are allowed because claim 14 specifically requires an eyewear member including a substantially planar body having an enclosure with at least one enlarged opening, said enlarged opening including a lens, wherein said body provides a close fit with a face of a person using said eyewear member, said eyewear member having at least one projection for extending around conventional eyewear and attached to said eyewear member for mounting said eyewear member in juxtaposition to the conventional eyewear.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claims 5,6,9,10,12,18,19,22-29,33-44, and 46-48 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in paper no. 10172003 and on page 25 of the present amendment (paper no. 05172004).

Applicant's remarks filed May 17, 2004 have been considered but are not deemed persuasive. On page 19, lines applicant states that claim 1 of the instant application requires a member which is utilized with conventional eyewear. Applicant further states that this is not the case with the Vinas reference and that pegs 28 can harm the user if the eyewear is worn with a disposable liner. Applicant should refer to Fig. 4 of Vinas which shows a member 2d which is utilized with conventional eyewear (note that there are no pegs on this eyewear). On page 21, lines 1-4 applicant states that Vinas does not enable user removability on a conventional eyewear such that the member can be removed to put the conventional eyewear in a configuration for conventional use. To the contrary col. 9, lines 58-60 of Vinas states that "shield 2d is removable from eyeglasses 1d by pulling shield 2d rearwardly, separating frame 4d from adhesive tapes 140,142,144". On page 24, lines 16-18 applicant states that nothing in Vinas indicates that a surface could or should be made impermeable for

superior sealing. As noted above, col. 5, lines 8-10 of Vinas states that shielding element 42 is constructed of open-cell foam that allows passage of air, but resists the passage of solid or liquid matter. It would have been obvious to form this entire foam layer so as to be impermeable to liquid since Vinas intends to make foam element resistant to permeability by a liquid. If the entire foam layer is constructed so as to be impermeable to liquid then the surfaces thereof would also be impermeable to liquid since the surfaces of the layer are a part of the layer itself.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter P Nerbun whose telephone number is 703-308-0955. The examiner can normally be reached on M-F (1st Week) M-Th (2d Week).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John J Calvert can be reached on 703-305-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-308-0758.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.

Peter Nerbun

September 2, 2004



Peter Nerbun
Primary Examiner